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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/422,565	10/21/1999	MEGUMI YOSHIDA	35.G2473	5702
5514 7590 05/07/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER TRAN, MYLINH T	
			ART UNIT 2179	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/422,565	<b>Applicant(s)</b> YOSHIDA, MEGUMI	
	<b>Examiner</b> Mylinh Tran	<b>Art Unit</b> 2179	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 February 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 9-25 and 28-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9-25 and 28-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Applicant's request for reconsideration has been entered and carefully considered. However, arguments regarding rejections under 35.U.S.C. 103 have not been found to be persuasive. Therefore, claims 1-6, 9-25 and 28-43 are rejected under the same ground of rejection as set forth in the Office Action mailed 09/07/06.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 6, 9-10, 13-16, 20-21, 25, 28-29, 32-35 and 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capps [US. 5,666,502] in view of the Screen Dumps (Microsoft Office).

**As to claims 1, 16, 20, 35 and 41-43**, Capps discloses a first displaying step of displaying an input screen for inputting a character string on a display (figure 5A, column 10, lines 45-65),  
a cursor designating step of designating, in the input screen displayed in the first displaying step, a cursor at a position on the input screen at which the character string is to be input (figure 5A-5B, column 10, line 45 through column 11, line 13);

Art Unit: 2179

a second displaying step of after the position of the cursor is designated in the input screen in the cursor designating step, displaying a list including a plurality of registered character strings on the display when a user enters an instruction to display the list (figure 5B, (200), column 11, lines 1-13);

selecting, based on a user instruction, a user desired character string from the plurality of the character strings displayed in the list in said second displaying step (figure 5B, column 11, lines 1-13 and lines 31-61);

in response to the user's selection of the registered character string in the selecting step, automatically inserting in the input screen displayed in the first displaying step the selected user desired character string at the designated position of the cursor designated in the cursor designating step (figure 7, column 12, line 24 through column 13, line 18) when the user desired character string is selected in said selecting step; Capps also teaches the step of character editing (column 11, lines 31-65).

Capps fails to clearly teach the feature of the inserted character string being added to image information which is to be sent to a destination. However, Microsoft Word (Screen Dumps) teaches this limitation at figure 6. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine the Microsoft Word teaching with the Capps's teachings. Motivation of the combining is to provide users extra information.

**As to claims 2 and 21**, Capps also discloses the selection of the character string being achieved by an instruction which designates a position in a region

Art Unit: 2179

of the display screen in which the character string to be selected is displayed (figure 5B, column 11, lines 1-14 and 32-61).

**As to claims 6 and 25**, Capps also shows the plurality of character strings having been registered through an operation performed by the user (figures 5B, 6A-6B, column 11, lines 14-31 and 61-6).

**As to claims 9-10 and 28-29**, Capps discloses the selected character string being input to a display screen which is displayed to enable entry of a character string designating a destination to which information is to be sent (figure 7, column 12, lines 24-67).

**As to claims 13, 15, 32 and 34**, Capps teaches instruction being given through a touch panel and the instruction being given through a coordinate input device (figure 5B, column 11, lines 31-62).

**As to claims 14 and 33**, Capps teaches instruction being given through a digitizer (column 5, lines 25-37).

Claims 3-5, 11-12, 17-19, 22-24, 30-31 and 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capps [US. 5,666,502] in view of Microsoft Office and further in view of An et al. [US. 5,936,614].

**As to claims 3, 4, 22 and 23**, Capps in view of Microsoft Office fails to clearly

Art Unit: 2179

teach a soft keyboard. However, An et al. shows the limitation at column 8, line 60 through column 9, line 12. It would have been obvious to one of ordinary skill in the art,

at the time the invention was made, to combine An's teaching of the soft keyboard with the modified Microsoft Office registered character strings.

Motivation of the combination would have been to store the character string by the soft keyboard to save time for the users.

**As to claims 5 and 24**, Capps in view of Microsoft Office fails to clearly teach the list including the registered character strings being displayed in place of the soft keyboard display screen. However, An et al. shows the list including the registered character strings being displayed in place of the soft keyboard display screen, in response to said instruction (column 13, lines 11-30). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine An's teaching of the soft keyboard with the modified Microsoft Office registered character strings. Motivation of the combination would have been to store the character strings by the soft keyboard to save time for the users.

**As to claims 11 and 30**, Capps in view of Microsoft Office fails to clearly teach the display of the registered character strings being displayed on an operation panel of a copying machine. However, An et al. show the feature at column 1, lines 31-53. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine An's teaching of the soft keyboard with

Art Unit: 2179

the modified Microsoft Office registered character strings. Motivation of the combination would have been to store the character strings by the soft keyboard to save time for the users.

**As to claims 12 and 31**, Capps in view of Microsoft Office fails to clearly teach the selected character string being output by means of a printer. However, An et al. show the feature at column 14, line 60 through column 15, line 19. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine An's teaching of the soft keyboard with the modified Microsoft Office's registered character strings. Motivation of the combination would have been to store the character strings by the soft keyboard to save time for the users.

**As to claims 17,18, 36-37 and 39-40**, Capps in view of Microsoft Office fails to clearly teach the editorial instruction being to add or delete a character. However, An et al. show the feature at column 2, lines 35-48. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine An's teaching of the soft keyboard with the modified Microsoft Office registered character strings. Motivation of the combination would have been to help the user having a desired character string.

**As to claims 19 and 38**, Capps in view of Microsoft Office fails to clearly teach the instruction being input through a displayed soft keyboard. However, An et al. show the features at column 3, lines 10-47. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine

An's teaching of the soft keyboard with the modified Microsoft Office registered character strings. Motivation of the combination would have been to store the character strings by the soft keyboard to save time for the users.

### ***Response to Arguments***

Applicant has argued that Capps in view of the Outlook screen dumps fail to teach or suggest the feature of designating a cursor at a position on an input screen at which a registered string is to be input, and after the position of the cursor is designated in the input screen, displaying a list including a plurality of registered character strings, whereby a user selects a string from the list and in response to the user's selection of the registered character string, the selected string is automatically inserted in the input screen at the designated position of the cursor.

However, the examiner respectfully disagrees for the following reasons:

Capps, as disclosed at figure 5A, teaches a pointer at a position where the diamond is (186) on the input screen (180). The pointer is at the position 186 on the input screen 180 at which the character string is to be input 184. At figure 5B, one of the character strings of the registered list (184) will be input at the field where the pointer is. It is clearly that Capps teaches designating a pointer at a position on an input screen at which a registered string is to be input.

Besides, the Outlook screen dumps disclose pointing a cursor at a position on the display screen at figure 4. The cursor position is at an input field



Art Unit: 2179

"To"; and the input field is inserted the selected character string (Tran, Mylinh) at the position pointed by the cursor (figure 5).

Therefore, it is very clearly that Capps in view of the Outlook screen dumps teach these features of designating a cursor at a position on an input screen at which a registered string is to be input, and after the position of the cursor is designated in the input screen, displaying a list including a plurality of registered character strings, whereby a user selects a string from the list and in response to the user's selection of the registered character string, the selected string is automatically inserted in the input screen at the designated position of the cursor.

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mylinh Tran. The examiner can normally be reached on Mon - Thu from 7:00AM to 3:00PM at 571-272-4141.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo, can be reached at 571-272-4847.

The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

571-273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mylinh Tran

Art Unit 2179



WEILUN LO

SUPERVISORY PATENT EXAMINER